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Paper No. 11

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In re Application of
Benini, Smith & Smith
Application No. 09/063,924
Filed: April 22, 1998
Attorney Docket No. 04110.0010U1

**OFFICE OF PETITIONS
A/C PATENTS**

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 26, 2000, to revive the above-identified application.

The petition is **dismissed**.

This application was filed on April 22, 1998, by Stephen L. Peterson (Reg. No. 26,325) of Finnegan, Henderson, Farabow, Garrett & Dunner. On December 16, 1998, Mr. Peterson, for himself and all the attorneys listed on the April 22, 1998 Declaration and Power of Attorney, requested to withdraw as counsel under 37 CFR 1.36. This request was approved on January 5, 1999. Therefore, on January 5, 1999 there were no attorneys of record and no official correspondence address of record. On January 21, 1999, Timothy G. Smith, a named inventor, attempted to change the correspondence address.

The change of correspondence address, filed January 21, 1999, was not acknowledged and made of record because only one of the three inventors signed it. All applicants for patent must sign the papers filed in the application. See 37 CFR 1.33(b)(5). As stated in MPEP 403 -- Correspondence - With Whom Held -- , in a joint application with no attorney, the applicant whose name first appears in the papers receives correspondence pertaining to the application. Accordingly, all Office correspondence was mailed to Mr. Benini, the first named applicant.

On June 17, 1999, a Restriction/Election Requirement was mailed to Mr. Benini's address. No reply was received, and the above-identified application became abandoned on July 18, 1999. On January 31, 2000, a Notice of Abandonment was

mailed to Mr. Benini's address.

The instant petition was filed by an attorney who is not empowered to prosecute this case. 37 CFR 1.33(b) requires that all amendments and other papers filed in the application must be signed by...(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of 1.34(a). 37 CFR 1.34(a) states that a registered attorney, when signing a paper in practice before the Patent and Trademark Office (PTO), is asserting that he or she is authorized to represent the particular party in whose behalf he or she acts. In the December 26, 2000 petition, Attorney Sumner C. Rosenberg asserts that he is acting in a representative capacity for Timothy G. Smith and Roger J. Smith. These two gentlemen are only two of the three named inventors. As such, Mr. Rosenberg was and is not acting in a representative capacity for all the inventors and the petition must be dismissed.

Meanwhile, the first named inventor, Mr. Benini, has obtained patent no. 6,090,178, issued July 18, 2000, based on a divisional continuation application, application no. 09/186,366, of the above-identified application. Attorney Stephen L. Peterson (Reg. No. 26,325) of Finnegan, Henderson, Farabow, Garrett & Dunner, the former attorney for the above-identified application, filed the continuation for Mr. Benini on January 5, 1998 while he was representing Messrs. Smith and Mr. Benini in the above-identified application. Mr. Benini is listed as the sole inventor of patent no. 6,090,178. Timothy G. Smith and Roger J. Smith were not aware of the abandonment of the above-identified application until patent no. 6,090,178 issued and the file history of application no. 09/186,366 became open to the public.

Given the unique facts surrounding this case, it is highly unlikely that Mr. Benini will join Messrs.. Smith and Smith to appoint an attorney, let alone cooperate with the revival and prosecution of the above-identified application.

Pursuant to 37 CFR 1.183, in an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the statutes may be suspended or waived by the Commissioner, subject to such other requirements as may be imposed. The Commissioner will allow this application to be revived solely for purposes of co-pendency upon the following conditions:

- (1) Petitioners must file a 1.53(b) continuation application claiming priority from the above-identified application.
- (2) A new oath or declaration must be submitted. Applicants must attempt to obtain Mr.

Benini's signature on the oath or declaration. If Mr. Benini refuses to join in the filing of the new 1.53(b) application, a petition under 37 CFR 1.47(a) should be filed. The granting of 1.47 status will enable Messrs. Smith and Smith to proceed with the prosecution of their invention without Mr. Benini's acquiescence.¹ A grantable petition under 37 CFR 1.47(a) requires:

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

(3) Subsequent to the filing of the new 1.53(b) application and the petition under 37 CFR 1.47(a) petition, applicants should petition under 37 CFR 1.183 to waive 37 CFR 1.33(b) and revive the above-identified application for purposes of copendency with the new 1.53(b) continuing application. A copy of this decision and the instant petition, filed December 26, 2000 should be included.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
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¹ A non-signing inventor is not entitled to prosecute the application if status under 37 CFR 1.47 has been accorded.

Telephone inquiries concerning this matter should be directed to Petitions Attorney E. Shirene Willis at (703) 308-6712.



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